

REMARKS

Claims 1-5 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims are said to contain subject matter which was not described in the specification in a manner which would reasonably convey to one of ordinary skill in the art that the inventor(s) were in possession of the invention as claimed at the time the application was filed.

In particular, the Examiner has stated that the ranges of OH number values for component c1) of the claims are not supported by the original disclosure, and that this is a new matter rejection. The Examiner also stated that the support Applicants' previously provided for this OH range has been considered, but the "cited OH number values are not supportive of the values now claimed".

Applicants respectfully disagree.

It is evident from Claim 1 above in the listing of claims that component c1) is "one or more release agents containing ester groups, said release agent being characterized by an OH number of about 43 to about 53...". Thus, the range of OH numbers in question is about 43 to about 53.

Support for the lower limit of the OH number range of about 43 is provided by FAPE 8 and FAPE 9 on page 7, lines 12-16 and on page 7, lines 17-20, respectively. Both FAPE 8 and FAPE 9 are described as the reaction product having an OH number of 43. Specifically, FAPE 8 is the reaction product of oleic acid, adipic acid and polyether having an OH number of about 600, and FAPE 9 is the reaction product of oleic acid, adipic acid and a polyether having an OH number of about 1,000. Thus, these two FAPE's which are both release agents containing ester groups and which comprise the reaction product of (i) one or more fatty acids having 10 to 40 carbon atoms, (ii) optionally, one or more dicarboxylic acids or polycarboxylic acids, and (iii) one or more polyetherpolyols with an OH number of 200 to 1,000 and a functionality of 2 to 6, support the lower end of the presently claimed OH number range. i.e. about 43.

Support for the upper limit of the OH number range of about 53 is provided by FAPE 3 on page 6, lines 12-16. FAPE 3 is the reaction product having an OH number of about 53, which comprises the reaction product of oleic acid, adipic acid and a polyether polyol having an OH number of about 1,000. Thus, FAPE 3 which is PO-7901

a release agent c1) as defined by the presently claimed invention provides support for the upper limit of the OH number range of about 53.

It is respectfully submitted that these working examples provide adequate support for the presently claimed range of OH numbers of about 43 to about 53 for component c1). One of ordinary skill in the art would know and recognize that the OH numbers of these FAPE's in the working examples are more than sufficient to support the range now being claimed as these FAPE's correspond to component c1) of the claims.

Applicants respectfully submit that these FAPE release agents were present in the application at the time it was filed, and that the OH numbers of these FAPE's were present at the time the application was filed. Thus, this is **not** new matter!

Furthermore, it is well within reason that one of ordinary skill in the art would consider the working examples as part of the specification. All of the application as originally filed in the U.S. Patent and Trademark Office, including the claims, is part of the specification!

The written description requirement, as set forth by the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences, in *Staehelin v. Secher*, 24 U.S.P.Q.2d 1513 (B.P.A.I. 1992), is intended to ensure that applicants had possession of a claimed invention as of the filing date and is satisfied if the application reasonably conveys this fact to those skilled in the art. E.g., 24 U.S.P.Q.2d at 1519. See also *In re Smith and Hubin*, 481 F.2d 910, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973), *In re Smythe and Shamos*, 480 F.2d 1376, 178 U.S.P.Q. 279, 284, as well as *In re Johnson and Farnham*, 194 U.S.P.Q. 187, 195 (C.C.P.A. 1977), and *In re Moore and Janoski*, 439 F.2d 1232, 1235, 169 U.S.P.Q. 236, 239 (C.C.P.A. 1971).

Applicants respectfully submit that the fact that there are two working examples of release agents which have an OH number of 43 which corresponds to the lower limit of the range now being claimed and that there is one working example of an release agent having an OH number of 53 which corresponds to the upper limit of the range now being claimed more than reasonably conveys that applicants had possession of the claimed invention, specifically with respect to the range of OH numbers, as of the filing date. These examples make it self-evident!

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It is respectfully submitted that a proper basis for rejecting the claims for lack of a written description does not exist. Nor is there support for a "new matter" rejection.

Applicants submit that the written description requirement is clearly satisfied by the present specification. The presently claimed OH number range of about 43 to about 53 for component c1) is not "new matter". It is respectfully requested that this rejection be withdrawn and Claims 1-5 be allowed.

Respectfully submitted,

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